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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/814, 141	03/06/97	WOHLSTADLER	J 370208-6158

021675  
BARRY EVANS  
WHITMAN BREED ABBOTT AND MORGAN  
200 PARK AVENUE  
NEW YORK NY 10166

HM42/1221

EXAMINER

ACHUTAMURTHY, P

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 12/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/814,141</b>	Applicant(s) <b>J. Wohlstadter et al</b>
	Examiner <b>P. Achutamurthy</b>	Group Art Unit <b>1618</b>

Responsive to communication(s) filed on Oct 5, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) 1-3 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 4-29 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

***Election/Restriction***

This is in response to the amendment filed October 5, 1998. Claims 1-7 were originally pending; new claims 8-29 have been added. Claims 4-7 have been elected in reply to the restriction requirement. The new claims 8-29 are considered as representative of the invention of Group III (claims 4-7, elected). Accordingly claims 4-29 have been examined on their merits in this office action.

Applicant's election with traverse of Group III, claims 4-7 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the inventions merely represent different embodiments of the same inventive concept, that adequate search of the inventions would necessarily encompass the same art, and that search for all the inventions would not constitute serious burden to the examiner. This is not found persuasive because the inventions are drawn to distinct subject matter involving search in different class and subclass of the US classification system. Moreover the method of Group I does not necessarily require the cassette disclosed in Group III. The invention of Group II calls for binding domains located on a support which can be sued in assay methods which do not require the measurement of electrochemiluminescence. The supported domains can be used in nonfluorescent immunoassays, for example.

The requirement is still deemed proper and is therefore made FINAL.

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***Drawings***

Please note the drawing deficiencies indicated on the attached copy of PTO-948.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Rejection A

Claims 4-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39, 42-49, 61-66, 78, and 79 of copending Application No. 08/611,804. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to the same or obvious variants of cassette (or kit or article) comprising electrodes having binding domains on their surfaces, the apparatus being useful in electrochemiluminescent assays..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection B

Claims 4-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-104 of copending Application No. 08/470,089. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although drafted differently, the claims are drawn to substantially the same apparatus embodiments, including kits, article, and system, comprising electrodes having binding domains on their surfaces, the apparatus being useful in electrochemiluminescence assays.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Rejection C

Claims 4-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-153 of copending Application No. 08/470,484. Although the conflicting claims are not identical, they are not patentably distinct from each other because , although drafted differently, the claims are drawn to substantially the same apparatus embodiments, including kits, article, and system, comprising electrodes having binding domains on their surfaces, the apparatus being useful in electrochemiluminescence assays.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection D

Claims 4-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-80 of copending Application No. 08/471,050. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although drafted differently, the claims are drawn to substantially the same apparatus embodiments, namely a kit comprising electrodes having binding domains on their surfaces, the apparatus being useful in electrochemiluminescence assays.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Rejection E

Claims 4-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-10, and 15-22 of copending Application No. 08/471,050. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although drafted differently, the claims are drawn to substantially the same apparatus embodiments, such as cassette, kit, apparatus etc, comprising electrodes having binding domains on their surfaces, the apparatus being useful in electrochemiluminescence assays.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1618.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P., Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

pa  
December 17, 1998

  
PONNATHAPURA ACHUTAMURTHY  
PRIMARY EXAMINER  
GROUP 1800